

§Appl. No. 10/812,398
Amdt. dated April 25, 2006
Reply to Office Action of, March 8, 2006

REMARKS/ARGUMENTS

Applicant expresses his sincere appreciation for the allowance of the subject matter of claim 3 which has been put in independent form in independent claim 7. Dependent claims 8-12, which depend from claim 7, recite the subject matter of initial claims 4, 5 and 10 with claims 9 and 10 depended from claim 8 and claims 11 and 12 depended from claim 7.

Applicant has addressed the Examiners concerns regarding 35 U.S.C. §112, second paragraph, by amending claim 1 to provide proper antecedent basis for "the display surface."

After reviewing the prior art, it remains Applicant's opinion that claim 1, as filed and amended to make definite under 35 U.S.C. §112, patentably distinguishes over the combination of Goins '390 and Alden '459.

In traversing this rejection, Applicant again respectfully submits that Goins '390 clearly does not include the following structure recited in claim 1:

"first and second wings extending from the display surface, the first and second wings having flanges thereon which are folded to form first and second tubes for receiving the elastic band therethrough with the elastic band being exposed between the first and second tubes for direct contact with a cover of a book with which the bookmark is used."

It is respectfully submitted that Alden '459 does not disclose a wing with flanges folding to form a tube. Where is the wing in Alden? Clearly, there is no wing in Alden. As is clear from Applicants' disclosure, the claimed wings are outboard of the image support area 38 between the wings. In Goins, the arrow head and tail are outboard of the center portion and therefore "correspond" to the claimed wings, but the arrow an tail are not folded to form first and second tubes to receive the elastic band, rather in Goins the elastic band is received through a pair of slits 3 adjacent a central solid portion 4. Goins does not disclose first and second tubes because the slits or apertures 2 are clearly not tubes.

In Goins '390 the elastic band is received through a section displaced inboard of the point and tail section of the arrow 2. Goins '390 is therefore completely non-analogous to Applicant's

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recitation of an elastic band being received through first and second tubes and can not be used to establish a *prima facie* case of obviousness when combined with a reference such as Alden '459.

It is respectfully submitted that Alden '459 does not cure this deficiency of Goins because Alden '459 does not have first and second wings either. Moreover, Alden '459 has a slider 1 which is mounted on a rigid body 2, rather than having a slider which is mounted on an elastic band. It is respectfully submitted that one skilled in the art having Goins and Alden for study would not, in the absence of Applicant's own teaching, combine these references so as to render claim 1 obvious. Actually, this combination of references renders Applicant's claimed invention unobvious because the claimed structure is not suggested in either reference.

Claim 1 further recites "first and second gaps in the first and second tubes" with the "gaps being in between opposed edges of the flanges folded to form first and second tubes." There are no tubes at all in Goins '390 because the central portion 4 is coplanar with, rather than in overlapping relationship with the outer portions of the arrow 2. In Goins '390, the elastic band 1 passes through a pair of slots rather than through a pair of tubes. While Alden '459 discloses in Fig. 2 structure which is tubular, there is only a single tube disclosed and no suggestion that a pair of tubes might be formed.

Accordingly, it is respectfully requested that the rejection under 35 U.S.C. §103 be withdrawn and that claims 1 and 2 be allowed because no *prima facie* case of obviousness has been established by the combination.

Further with respect to claim 2, claim 2 has been finally rejected as unpatentable over Goins '390 in view of Alden '459 and further in view of Porto '950. This final rejection is also traversed.

While Porto '950 may teach applying a sticker to a surface of a bookmark, Porto '950 does not cure the deficiencies of the Goins '390-Alden '459 combination. This is because there is absolutely no disclosure in Porto of first and second tubes with first and second gaps as claimed in Applicant's claim 1. Since claim 2 necessarily includes all of the limitations of claim 1, claim 2 is allowable for the same reasons as claim 1.

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It is respectfully submitted that this is a full and complete response to the Final Rejection of March 8, 2006, and as such places this application in condition for allowance. Allowance therefore is respectfully requested. If the Examiner for any reason feels a personal conference with Applicants' attorneys might expedite prosecution of this application, the Examiner is respectfully requested to telephone the undersigned locally.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



John R. Moses, Reg. No. 24,983

Millen, White, Zelano & Branigan
Arlington Courthouse Plaza
2200 Clarendon Blvd.
Suite 1400
Arlington, VA 22201
(703) 812-5309

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